

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: December 2, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re London Dairy Company Limited

Serial No. 76311561

Dyann L. Kostello and Ariana G. Voigt of Michael Best & Friedrich LLP for London Dairy Company Limited.

Elizabeth A. Hughitt, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Chapman, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

London Dairy Company Limited (a United Kingdom company) filed on September 13, 2001, an application to register on the Principal Register the mark shown below



for "ice creams" in International Class 30. The application is based on (i) Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), applicant's assertion of a bona

fide intention to use the mark in commerce, and (ii) Section 44 of the Trademark Act, 15 U.S.C. §1126, applicant's ownership of United Kingdom Registration No. 2276382. Applicant disclaimed the term "dairy."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark shown below



for "dairy products, namely, packaged milk, cream and cottage cheese" in International Class 29 and "ice cream" in International Class 30.²

Applicant appealed, and briefs have been filed. Applicant did not request an oral hearing.

Preliminarily, we address applicant's strongly-urged request that the Board reverse the Examining Attorney's refusal to register "because a prior Examining Attorney had already approved this mark, rendering the new Examining

¹ Applicant agreed to disclaim the word "dairy" in its brief on appeal (p. 6), and the Examining Attorney accepted the disclaimer (brief, p. 2).

² Registration No. 1387655, issued March 25, 1986 to London's Farm Dairy, Inc. (a Michigan corporation); Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Attorney's absolute refusal to register unfair and unduly burdensome to Applicant." (Applicant's brief, pp. 1-3.)

The Examining Attorney asserts that applicant's position is understandable, but it is insufficient to warrant a withdrawal of the refusal to register; and that the previous handling of the application (including an erroneous reference to a prior pending application, apparent misunderstanding of applicant's response to the disclaimer requirement, overlooking the question of the applicant's entity and stippling on the drawing) warranted a careful review of all issues in this application, including the prior Examining Attorney's withdrawal of the Section 2(d) refusal.

TMEP §713.01 (4th ed. 2005) reads as follows: "When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should not take an approach that is entirely different from that of the previous examining attorney unless it is clearly appropriate to do so." (Emphasis added.)

In the circumstances of this application, i.e., involving certain apparent errors in the examination by the first Examining Attorney, and the nature of the marks (particularly the word portions) and the identical and

related goods, it was clearly appropriate for the current Examining Attorney to reinstate the refusal to register the mark under Section 2(d). Thus, applicant's request that the reinstated refusal to register under Section 2(d) be reversed as it is "unfair" and "burdensome" to applicant is denied.

We now consider the merits of the refusal to register. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the goods. Applicant's identified goods "ice creams" and the cited registrant's identified item "ice cream" are legally identical. Moreover, the remainder of the cited

registrant's identified goods, "packaged milk, cream and cottage cheese" are related to applicant's "ice creams," as indicated by the third-party registrations, based on use in commerce, made of record by the Examining Attorney. See, for example, Registration No. 2066481 for, inter alia, "milk," "cottage cheese" and "ice cream"; Registration No. 2325294 for, inter alia, "milk," "cottage cheese" and "ice cream"; Registration No. 2387189 for, inter alia, "milk," "cottage cheese, "cream" and "ice cream"; and Registration No. 2752039 for, inter alia, "milk" and "ice cream." See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Applicant did not argue the issue of the goods, and we find that the identified goods are in part identical, and are otherwise related. Likewise applicant did not argue, and we do not find, any differences in the channels of trade or purchasers. We must presume, given the identifications (neither of which is limited), that the goods are offered through the same channels of trade to the same classes of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In addition, these products are neither expensive nor purchased with a great degree of care.

Turning to the marks, our primary reviewing Court has stated the following: "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant argues that the marks LONDON'S with a design including a barn, and LONDON DAIRY with a design including the London Bridge, are dissimilar in sound and appearance; that the registered mark is a possessive term relating to either a person named London or that the goods are owned by the city of London, while applicant's mark does not have those connotations; that the design features of the two marks create different commercial impressions with the registered mark suggesting "straight-from-the-farm fresh" and applicant's design feature suggesting "the feel of a city or urban environment" (brief, p. 4); that the unique designs coupled with the differences in the word portions of the marks renders confusion unlikely; and that the Examining Attorney's focus on the word LONDON and LONDON'S constitutes an improper dissection of the marks.

The Examining Attorney argues that the words are the dominant portions of both marks; that the minor differences

in the word portions are not sufficient to obviate a likelihood of confusion; that the possessive form of a term remains highly similar to the term itself; that the addition of the highly descriptive, if not generic, term "dairy" to applicant's mark does not obviate the likelihood of confusion; that registrant's website includes a customer e-mail in which the customer states "The members of our team always stop here for ice cream after the tournament in Port Huron. While we all know it fondly as 'The London Dairy'..."; that while the design features are not the same, nonetheless, it is the word portion of a mark that is generally used by consumers to call for the goods; that the London Bridge design in applicant's mark is particularly small, and the farm scene in the registered mark is simply suggestive in the context of dairy products; that, as applicant acknowledges (brief, p. 3), LONDON'S could be perceived by consumers as relating to the city of London, and the London Bridge design in applicant's mark would likewise have consumers thinking of the city of London; that, when considered as a whole, the marks are similar; and that doubt on the issue of likelihood of confusion is resolved in favor of registrant.

It is well settled that marks must be considered in their entirety because the commercial impression of a

mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2005). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). The proper test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the similarity of the general commercial impressions engendered by the involved marks.

In this case, applicant's mark is LONDON DAIRY and design and registrant's mark is LONDON'S and design. The marks are highly similar in sound, and it is the words or literal portions of the marks (LONDON DAIRY and LONDON'S) that would be utilized in calling for the goods. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987).

The design feature in applicant's mark consists of a curved carrier design and a small stylized design of a bridge, while registrant's design feature is that of a barn with trees and silos appearing above a black banner

carrying the word LONDON'S, all inside an oval or circle. Obviously these are different designs, but we must keep in mind, as stated previously, that the proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks. Rather, the determination must be based on the recollection of the purchasers, who normally retain a general rather than specific impression of the many trademarks encountered; that is, a purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

In connotation, both marks suggest the city of London. Further, the Examining Attorney has made of record an on-line dictionary definition of the word "dairy" as "1. A commercial establishment for processing or selling milk and milk products. 2. A place where milk and cream are stored and processed 3. A dairy farm" Clearly, the term "dairy" in applicant's mark and the farm design in registrant's mark both connote a dairy and/or dairy farm, particularly in the context of the involved goods.

When the marks are considered in their entireties, the differences identified above are not sufficient to obviate

a likelihood of confusion between these marks, LONDON DAIRY and design and LONDON'S and design. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Considering all of the relevant du Pont factors in this case, that is, identical and closely related goods, identical trade channels and purchasers, low-cost impulse purchasing, and similar marks, we conclude that consumers familiar with registrant's ice cream and other dairy products offered under the mark LONDON'S and design would be likely to believe, upon encountering the mark applicant asserts it has an intention to use, LONDON DAIRY and design for ice creams, that both originate with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.